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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,814	09/17/2003	Michael E. Caban	38763.1540	4052
28765	7590	01/10/2005		
WINSTON & STRAWN PATENT DEPARTMENT 1400 L STREET, N.W. WASHINGTON, DC 20005-3502			EXAMINER NGUYEN, ANTHONY H	
			ART UNIT 2854	PAPER NUMBER

DATE MAILED: 01/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/663,814

Applicant(s)

CABAN ET AL.

Examiner

Anthony H Nguyen

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 21-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 21-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 U.S.C. § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,4-7, 10-12, 21, 24-29, 33,37, 41, 42 are rejected under 35 U.S.C. 102(b) as being anticipated by Sakaki et al. (US 5,751,306).

With respect to claims 1, 6, 7, 12, 21, 26, 33 and 42, Sakaki et al. teaches a document and method of producing the document including the steps of providing a substrate 10 having a base material 12 which includes a first face formed of standard paper being capable of receiving printing indicia and applying a debris-removing coating 16 position on the second face of the substrate opposed to the first face to remove the printer debris during passage of the document through the printer for printing the printing indica (Sakaki et al. , col.3 lines 20-59 and col.4 lines 20-25). With respect to claims 4, 5, 10, 11, 24 and 25, Sakaki et al. teaches the conventional use of polymeric coating or polymeric-self adhesive (Sakaki et al., col. 3 lines 45-51 and colored sheet (Sakaki et al., col.4 lines 26-28). With respect to claims 27-30, the debris-removing coating layer 16 of Sakaki et al. which is an adhesive layer that inherently removes the contamination in the printer such as ink deposits, paper dust deposits or the adhesive build-up.

Claim Rejections - 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) a patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 3, 8, 9, 22, 23, 30-32, 34-36, 38-40 and 43-47 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Sakaki et al. (US 5,751,306) in view Casper et al. (US 5,782,496).

With respect to claims 2, 8, 22, 31, 35, 45 and 46, Sakaki et al. teaches all that is claimed, except the substrate which comprises a label. Casper et al. teaches a substrate 11 having a first face which is coated with an adhesive including a label 22 as shown in Fig. 2 of Casper et al. In view of the teaching of Casper et al., it would have been obvious to one of ordinary skill in the art to modify the document of Sakaki et al. by substituting the substrate as taught by Casper et al. for ensuring optimal print quality on a label in place of the substrate 10 of Sakaki et al.. With respect to claims 3, 9, 23, 34, 38, 43 and 44 the selection of the desired debris-removing coating having a desired brand or product or a laser-receptive cleansing and the step of re-passing the document through the printer for printing or cleaning would be obvious through routine experimentation in order to get optimum cleaning effects.

Response to Arguments

Applicants' arguments filed on October 28, 2004 have been fully considered but they are not persuasive of any error in view of the new ground(s) of rejections.

Conclusion

The patents to Ikeda et al., Gelardi et al., Kennett, Campbell and Amann are cited to show other structures and methods having obvious similarities to the claimed structure and method.

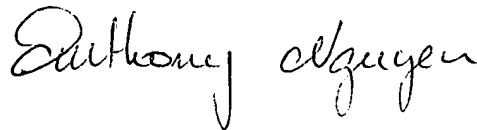
Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Nguyen whose telephone number is (571) 272-2169. The examiner can normally be reached daily from 9 AM to 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld, can be reached on (571) 272-2168. The fax phone number for this Group is (703) 872-9306.

A handwritten signature in cursive script that reads "Anthony Nguyen".

Anthony Nguyen
1/6/05
Patent Examiner
Technology Center 2800